

## **REMARKS**

### **I. Introduction**

With the cancellation without prejudice of claims 10 and 12, claims 9, 11 and 13 to 22 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant expresses appreciation for the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

### **II. Rejection of Claims 9, 10, 12 and 13 Under 35 U.S.C. § 102(b)**

Claims 9, 10, 12 and 13 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,641,126 ("Nally et al."). It is respectfully submitted that Nally et al. do not anticipate these claims for at least the following reasons.

Claim 9 relates to a fuel injector for a fuel-injection system of an internal combustion engine, including: a solenoid coil; a tubular support acting as an inner pole of the solenoid coil; and a filter element affixed on an outer contour of the tubular support.

Although Applicant may not agree with the merits of the rejection, to facilitate matters, claim 9 has been amended, inter alia, to incorporate the features of claims 10 and 12, claims 10 and 12 have been canceled without prejudice, and claims 11, 13 to 15 and 17 have been amended to change their dependencies to claim 9. Claim 9 as amended recites, in relevant parts, that **the outer contour of the tubular support includes grooves, the tubular support includes a shoulder on the discharge side of the grooves; and the shoulder extends radially outward beyond outer edges of the grooves.**

Nally et al. do not disclose, or even suggest, that an outer contour of a tubular support of a fuel injector includes grooves. **As is apparent from Fig. 1 of Nally et al., the adjusting sleeve 38, which the Office Action considers to constitute a tubular support, includes one groove, and not a plurality of grooves.** In addition, Nally et al. do not disclose, or even suggest, that a shoulder of a tubular support of a fuel injector extends radially outward beyond outer edges of the grooves. **As is apparent from Fig. 1 of Nally et al., the bottom of groove 76,**

**which the Office Action considers to constitute a shoulder, is a part of the groove 76 and does not extend radially outward beyond outer edges of the groove 76.** Accordingly, it is respectfully submitted that Nally et al. do not anticipate claim 9 for at least these reasons.

As mentioned above, claims 10 and 12 have been canceled without prejudice, thereby rendering moot the rejection with respect to these claims.

As for claim 13, which depends from claim 9 and therefore includes all of the features of claim 9, it is respectfully submitted that Nally et al. do not anticipate this dependent claim for at least the reasons set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 11 and 14 to 22 Under 35 U.S.C. § 103(a)**

Claims 11 and 14 to 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nally et al. It is respectfully submitted that Nally et al. do not render these claims unpatentable for at least the following reasons.

Claim 22 includes features analogous to claim 9 and has been amended in a manner analogous to claim 9. In addition, as set forth in detail in Section II of this response, Nally et al. do not disclose, or even suggest, all of the features of claim 9. Accordingly, it is respectfully submitted that Nally et al. do not render unpatentable claim 22 for at least these reasons.

Claims 11 and 14 to 21 ultimately depend from claim 9 and therefore include all of the features of claim 9. As set forth above, Nally et al. do not disclose, or even suggest, all of the features of claim 9. Accordingly, it is respectfully submitted that Nally et al. do not render unpatentable claims 11 and 14 to 21, which depend from claim 9.

As regards claims 14 to 16, it is respectfully submitted that Nally et al. do not render these claims unpatentable for the following additional reasons. Nally et al. do not disclose, or even suggest, a fuel injector that includes an extension sleeve surrounding an exterior of a filter element, where the extension sleeve has an inner diameter that is slightly smaller than an outer diameter of the filter element, and where a press-fit between the filter element and a tubular support is achieved by the extension sleeve. As admitted by the Office Action, the filter connector 72 of Nally et al. is not press-fit to the adjusting sleeve 38 by the inlet tube 24. In addition, **the**

*motivation for increasing the diameter of the filter 66 of Nally et al. for achieving a press-fit, namely, to more securely fasten the filter 66 in place, is untenable, since the filter 66 is already securely attached to the adjusting sleeve 38 by the latching fingers 74 of filter connector 72. Furthermore, increasing the outer diameter of filter 66 to a value slightly larger than the inner diameter of the inlet tube 24 to obtain a press-fit with adjusting sleeve 38 would prevent the adjusting sleeve 38 from being screwed into the inlet tube 24 and/or produce shavings from the filter connector 72 or the inlet tube 24 inside the inlet tube 24, thereby inhibiting the proper functioning of the fuel injector.* Accordingly, it is respectfully submitted that Nally et al. do not render claims 14 to 16 unpatentable for these additional reasons.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Conclusion**

In light of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Date: October 14, 2008

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